

Appl. No. 09/720,623  
AMENDMENT  
Docket No. MAEJ-136

### REMARKS

Claims 1-11 are pending. By this Amendment, the specification and Claims 1-3, 7, and 9-10 are amended, and new Claim 11 is added. Support for the claim amendments and new claim is found in the specification at, *inter alla*, page 7, line 3 - page 10, line 20 and in the original claims. No new matter is added by this Amendment.

Applicants thank Examiner David Aylward for indicating that Claims 1 and 3-6 are allowed and that Claims 7 and 10 recite allowable subject matter. Claims 7 and 10 are amended to be in independent form.

#### I. REJECTION UNDER 35 U.S.C. 103(a)

Claims 2 and 8-9 were rejected under 35 U.S.C. 103(a) over U.S. Patent No. 5,336,752 (Oshimi et al.). This rejection is respectfully traversed.

Oshimi et al. discloses a phenolic resin produced by: (1) reacting a phenol with an unsaturated cyclic hydrocarbon compound having 2 or more carbon-carbon double bonds in the presence of an acid catalyst; and (2) processing the resulting reaction product by a hydrotalcite compound (Abstract).

Oshimi et al. discloses reacting phenol with tetrahydroindene (Example 3); vinyl cyclohexene (Example 4); and vinyl norbornene (Example 5) at a temperature of 80°C and then at a temperature of 140°C. Examples 1-2 of Oshimi et al. disclose the reaction of dicyclopentadiene with a phenolic compound at a reaction temperature of 80°C. However, Oshimi does not teach or suggest: (1) reacting a phenolic compound and dicyclopentadiene in the presence of an acid catalyst in the range of 50°C to 90°C; and (2) increasing the temperature to 110°C or higher after addition of dicyclopentadiene, as

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recited in Claim 2. The compounds of Examples 3-5 of Oshimi et al. must be subjected to higher temperatures due to their low reactivity. There is no recognition or appreciation in Oshimi that by increasing the temperature in the reaction of a phenolic compound and dicyclopentadiene, which has high reactivity, a dicyclopentadiene-phenol resin having superior moisture, heat-resistant, and crack-resistant properties can be obtained. See specification at page 1, lines 6-19. Moreover, the resulting dicyclopentadiene-phenol resins have an excellent hue. Thus, it would not have been obvious for one of ordinary skill in the art to practice the methods of Claims 2 and 8-9 in view of the teachings of Oshimi. Reconsideration and withdrawal of the rejection are respectfully requested.

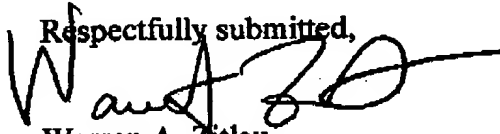
## II. CONCLUSION

In light of the foregoing remarks, this application is in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application.

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Respectfully submitted,



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